

REMARKS**DRAWINGS**

The Office Action includes an objection under 37 CFR 1.83(a) to the drawings, indicating that the drawings do not include each feature in the claims. The claims have been amended. The drawings include each feature of the amended claims.

CLAIM OBECTIONS

Claims 1, 5, 13 and 14 are objected to in the Office Action as including certain listed informalities. Claims 5-12 have been cancelled without prejudice or disclaimer. Claims 1, 13, and 14 have been amended to remedy the identified informalities.

CLAIM REJECTIONS

Claims 1-4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Porat et al. U.S. Pat. Pub. No. 2004/0057509 ("Porat") in view of Roh U.S. Pat. Pub. No. 2003/0061321 ("Roh"). Claim 5 stands rejected 35 U.S.C. 103(a) as being unpatentable over Johnson et al. U.S. Pat. Pub. No. 2004/0109457 ("Johnson") in view of Roh. Claims 13-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Roh in view of Porat. Claims 17 and 18 stands rejected 35 U.S.C. 103(a) as being unpatentable over Roh in view of Johnson. Claim 5 has been cancelled without prejudice or disclaimer. Applicants respectfully traverse each remaining rejection.

Claims 1-4 are allowable over Porat in view of Roh

Applicants respectfully submit that the Office Action fails to establish a prima facie case of obviousness with respect to claims 1-4. Establishing a prima facie case of obviousness requires:

- 1) there must be a suggestion or motivation to make the asserted combination, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art;
- 2) there must be a reasonable expectation of success; and

3) the alleged combination must teach or suggest all the claim limitations.

See M.P.E.P. §2142.

Applicants submit that the asserted combination fails to teach or suggest each of the elements recited in the claims.

Claim 1 recites detecting the presence of a powered-on network capable device that is connected to a DSL modem on a local network. The Office Action states that Porat, at Figure 2, reference numerals 2-1 and 2-9, and at page 3, paragraph [0062], lines 12-18, discloses detecting the presence of a powered-on network capable device that is connected to a DSL modem. *Office Action*, p.4, 4th paragraph. Applicants respectfully submit that what Porat, at Figure 2, reference numerals 2-1 and 2-9, discloses is a data source (reference numeral 2-1) in communication with an xDSL modem in a central office (reference numeral 2-9). *See Porat*, p. 2, paragraph [0060], lines 1-12. The central office xDSL modem (2-9) is not connected to the data source (2-1) on a local network. *See Porat*, p.1, paragraph [0002], lines 1-7. Therefore, the data source and central office xDSL modem of Porat do not disclose or suggest detecting the presence of a powered-on network capable device that is connected to a DSL modem on a local network as recited in claim 1.

Further, Porat states:

When the user turns on the power of the user modem 4 and wishes to establish a data connection, the user modem 4 generates a wake-up signal and sends it via the telephone line 8 to the corresponding xDSL modem 9 in the central office.

Porat, p. 3, paragraph [0062], lines 12-16.

That is, the central office xDSL modem appears to detect a powered on user modem via a telephone line. The central office xDSL modem of Porat does not disclose or suggest detecting the presence of a powered-on network capable device that is connected to a DSL modem on a local network. Rather, the central office xDSL modem of Porat is connected to the user modem via a remote network.

The Office Action does not allege that Roh discloses or suggests detecting the presence of a powered-on network capable device that is connected to a DSL modem on a local network, and, in fact, Roh does not disclose or suggest this element of claim 1. Since at least one element

of claim 1 is not disclosed or suggested by the combination of Porat and Roh, the Office Action has not established a prima facie case of obviousness with regard to claim 1. Claim 1 is, therefore, allowable.

Claims 2-4 depend from claim 1. Since the Office Action does not establish a prima facie case of obviousness with regard to claim 1, it also fails to establish a prima facie case of obviousness with regard to claims 2-4. Claims 2-4 are, therefore, allowable, at least in light of their dependence from claim 1.

Claims 13-16 are allowable over Roh in view of Porat

Claim 13 recites detection logic to detect the presence of a powered-on network capable device that is connected to the DSL router via a local network. The Office Action acknowledges that Roh does not disclose or suggest detection logic to detect the presence of a powered-on network capable device that is connected to the DSL router. *Office Action*, p.8, 3rd paragraph. However, the Office Action asserts that Porat, at Figure 2, Figure 4, and p.3, paragraph [0066], lines 12-18, discloses detection logic to detect the presence of a powered-on network capable device that is connected to the DSL router. *Office Action*, p.8, 6th paragraph. Applicants respectfully disagree.

As previously discussed, Figure 2 and p.3, paragraph [0066] of Porat disclose a remote central office xDSL modem receiving a wake up signal from a user modem via a telephone line. The central office xDSL modem, user modem, and wake up signal of Porat do not disclose or suggest detection logic to detect the presence of a powered-on network capable device that is connected to the DSL router via a local network, as recited in claim 13.

Claims 14-16 depend from claim 13. Since the Office Action does not establish a prima facie case of obviousness with regard to claim 13, it also fails to establish a prima facie case of obviousness with regard to claims 14-16. Claims 14-16 are, therefore, allowable, at least in light of their dependence from claim 13.

Claims 17 and 18 are allowable over Roh in view of Johnson

Claim 17 recites a network connection made over the digital subscriber line after lease

assignment logic has assigned a lease to the network capable device. The Office Action states that Roh, at p. 4, paragraph [0061] discloses this element of claim 17. *Office Action*, p. 10, 1st paragraph. Applicants respectfully disagree. In context, what Roh actually discloses is:

The DHCP server 52 of the ADSL modem 50 transfers to the client PC 10 the related information of the IP configuration information including a default address of the ADSL modem 50 through the DHCPOFFER packet in response to the DHCPDISCOVER packet. The packet transferred to the client PC 10 includes the following:

[0060] the global address, the gateway address, and the DNS server address ad (including the primary-DNS-address and secondary-DNS-address if available) an obtained from the NAS 40;

[0061] values for lease time, lease renewal time (T1) and lease renewal time (T2). (A period of 5 seconds is reasonable for promptly applying the values of the above item (c) in the client PC 10 according to the test result.); and

[0062] a minimum value of the subnet mask assembled from the gateway IP address and the global IP address.

Roh, p. 4, paragraphs [0059]-[0062].

Additionally, Roh at p. 3, paragraph [0054] states:

After the PPP session is connected, the IPCP 54 obtains the IP configuration information including the IP address, the gateway IP address, and the DNS server address, all of which are used in the client PC 10.

Roh, p. 3, paragraph [0054].

That is, Roh discloses that a point-to-point protocol (PPP) connection is established to a remote server to obtain IP configuration information (including an IP address, a gateway IP address, and a DNS server address) which is then passed to the client computer as part of a lease assignment process. In other words, in the method of Roh, a network connection is made over a digital subscriber line before a lease is assigned to the client computer. Making a network connection before assigning a lease to a client PC does not disclose or suggest that a network connection is made over the digital subscriber line after the lease assignment logic has assigned a lease to the network capable device, as recited in claim 17.

Further, Applicants submit that the combination of Roh and Johnson is improper because

Roh and Johnson are technically incompatible. In particular, it is an express object of Roh to remove network address translation (NAT) from a modem. *Roh*, p.2, paragraph [0030]. In direct contrast, Johnson discloses a gateway device (acting as a router and modem) that implements both NAT and DHCP. *See Johnson*, p. 2, paragraph [0024]. Thus, combining the gateway device of Johnson with the modem of Roh would require fundamentally changing the principle of operation of Roh. If the proposed modification or combination of the prior art would change of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *MPEP* § 2143.01 VI (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Since the combination of Roh and Johnson is improper, the combination fails to establish a *prima facie* case of obviousness with regard to claim 17.

Claim 18 depends from claim 17. Since the Office Action does not establish a *prima facie* case of obviousness with regard to claim 17, it also fails to establish a *prima facie* case of obviousness with regard to claim 18. Claim 18 is, therefore, allowable, at least in light of its dependence from claim 17.

Claims 19-22 have been added. Claims 19-22 include no new matter.

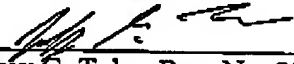
Any changes to the claims in this amendment, which have not been specifically noted to overcome a rejection based upon cited references, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto. Applicants' failure to challenge any cited reference as prior art should not be construed as an admission by Applicants that the unchallenged reference does constitute prior art.

Claims 1-4, and 13-22 are allowable for at least the reasons stated above. Applicants respectfully submit that the present application is in condition for allowance. Accordingly, the Examiner is requested to issue a Notice of Allowance for all pending claims.

Applicants do not believe that any additional fees are due, but if the Commissioner believes additional fees are due, the Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

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